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Mail Stop Patent Application  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Express Mail No.:** EV 314103476 US  
**Attorney's Docket No.:** 2003080-0143 (SK-744-CON9)  
**Date Filed:** December 2, 2003

**UTILITY PATENT APPLICATION TRANSMITTAL**  
(FOR NEW NONPROVISIONAL APPLICATIONS UNDER 37 C.F.R. § 1.53(B))

Dear Sir:

Please find enclosed a patent application and papers as follows for:

**Inventor(s):**

<u>Given Name (first and middle)</u>	<u>Family Name or Surname</u>	<u>Residence (City and State or Foreign Country)</u>
Samuel J.	Danishefsky	Englewood, NJ
Peter	Bertino	Old Lyme, CT
Dai-Shi	Su	New York, NY
Dongfang	Meng	New York, NY
Ting-Chao	Chou	Paramus, NJ
Ted	Kamenecka	New York, NY
Erik J.	Sorensen	San Diego, CA
Aaron	Balog	New York, NY
Kenneth A.	Savin	New York, NY

**Title of the Invention:** **Synthesis of Epothilones, Intermediates Thereto, Analogues and Uses Thereof**

1) ☒ **Fee Transmittal Form** (original and duplicate submitted for fee processing)

2) ☐ **Applicant Claims Small Entity Status** (see 37 CFR § 1.27)

a) ☐ Statement Verifying Small Entity Status (optional)

3) ☒ **Specification**

TOTAL PAGES: 112

(87 pp. description; 24 pp. claims; 1 pg. abstract)

☒ Descriptive Title of the Invention

☒ Cross References to Related Applications (if applicable)

☒ Statement Regarding Federally Sponsored R & D (if applicable)

☐ Reference to sequence listing, a table, or a computer program listing appendix

☒ Background of the Invention

☒ Summary of the Invention

☒ Description of the Drawing (if filed)

☒ Detailed Description of the Invention

☒ Claim(s)

☒ Abstract of the Invention

4) ☒ **Drawing(s)** (35 U.S.C. § 113)

TOTAL SHEETS: 59

a) ☒ Formal Drawings (if checked)

TOTAL SHEETS: 76

5) ☒ **Oath or Declaration**

TOTAL PAGES: 10

a) ☐ Newly Executed (original or copy)

b) ☒ Copy from a prior application (37 C.F.R. § 1.63(d))-for  
continuation/divisional application

i) ☐ Deletion of inventor(s): Signed Statement deleting inventor(s) named  
in the prior application, see 37 C.F.R. §§ 1.63(d)(2) and 1.33(b).

c) ☐ Unexecuted

6) ☐ **Application Data Sheet**. See 37 C.F.R. § 1.76.

7) ☐ **CD-ROM or CD-R in duplicate, large table or Computer Program  
(Appendix)**

8) ☐ **Nucleotide and/or Amino Acid Sequence Submission** (if applicable, all are necessary)

a) ☐ **Computer Readable Form (CRF)**

b) ☐ **Specification Sequence Listing on:**

i) ☐ **CD-ROM or CD-R (2 copies); or**

ii) ☐ **Paper**

c) ☐ **Statements verifying identity of above copies**

**B) ACCOMPANYING APPLICATION PARTS:**

9) ☒ **Assignment Papers** (cover sheet & document(s))

10) ☐ **37 C.F.R. § 3.73(b) Statement** (when there is an assignee)

11) ☒ **Power of Attorney**

12) ☐ **English Translation Document** (if applicable)

13) ☒ **Information Disclosure Statement (IDS)/PTO-1449 (5 pp. total)**

14) ☐ **Copies of IDS Citations**

15) ☒ **Preliminary Amendment (15 pp.)**

16) ☒ **Return Receipt Postcard (MPEP 503)** (specifically itemized)

17) ☐ **Certified Copy of Priority Document(s)** (if foreign priority is claimed)

18) ☒ **OTHER:** (if applicable, specified below)

**Identification of Patent Under 37 CFR §1.607(c) (1 pg.)**

**C) FOR CONTINUING APPLICATIONS:** (the appropriate box is checked, and certain information is provided below and in a preliminary amendment)

☒ **continuation**

☐ **divisional**

☐ **continuation-in-part (CIP)**

of prior application no.: 10/431,467

filed: May 7, 2003

examiner: T. Solola

group/art unit: 1626

**FOR CONTINUATION OR DIVISIONAL APPLICATIONS ONLY:** The entire disclosure of the prior application, from which an oath or declaration is supplied as detailed above, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference.

D.) PRIORITY CLAIM(S):

This application claims the benefit under 35 U.S.C. § 120 of any United States application(s) or PCT international application(s) designating the United States of America listed below:

<u>Application Serial No.</u>	<u>Filing date</u>	<u>Status (patented, pending, abandoned)</u>
08/986,025	December 3, 1997	Patented
09/691,615	October 18, 2000	Patented
09/662,426	September 13, 2000	Patented
09/686,158	October 11, 2000	Patented
09/808,451	March 31, 2001	Patented
09/874,514	June 5, 2001	Pending
10/004,571	December 4, 2001	Pending
10/058,695	January 28, 2002	Pending
10/374,805	February 25, 2003	Pending
10/431,467	May 7, 2003	Pending
10/695,582	October 28, 2003	Pending

This application claims the benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below:

<u>Application Serial No.</u>	<u>Filing date</u>	<u>Status (pending, expired, abandoned)</u>
60/032,282	December 3, 1996	Expired
60/033,767	January 14, 1997	Expired
60/047,566	May 22, 1997	Expired
60/047,941	May 29, 1997	Expired
60/055,533	August 13, 1997	Expired

E) METHOD OF PAYMENT OF FILING FEES FOR THIS APPLICATION:

- ☐ Applicant claims small entity status 37 C.F.R. § 1.27.
- ☒ A check is enclosed to cover the filing fees.
- ☒ The commissioner is hereby authorized to charge filing fees or to credit any overpayment to deposit account number 03-1721.


F) CORRESPONDENCE ADDRESS:

☒ Customer Number: 24280

☒ Correspondence Address:

Patent Department  
Attn: C. Hunter Baker, M.D., Ph.D.  
Choate, Hall & Stewart  
53 State Street  
Exchange Place  
Boston, MA 02109  
phone: (617) 248-5000  
fax: (617) 248-4000

Respectfully Submitted,

  
C. Hunter Baker, M.D., Ph.D.  
Reg. No.: 46,533

CHOATE, HALL & STEWART  
53 State Street  
Exchange Place  
Boston, MA 02109

**CERTIFICATE OF EXPRESS MAILING**

"Express Mail" mailing label number EV 314103374 US; Date of Deposit: December 23, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service as "*Express Mail Post Office to Address*" service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

December 2, 2003

Date

  
Signature

Linda M. Amato

Typed or Printed Name of person signing certificate

Express Mail No.: EV 314103476 US  
Date Filed: December 2, 2003

15992 U.S. PTO  
120203

# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ ) 770.00

## Complete if Known

Application Number	Not yet assigned
Filing Date	December 2, 2003
First Named Inventor	Samuel J. Danishefsky
Examiner Name	Not yet assigned
Art Unit	Not yet assigned
Attorney Docket No.	2003080-0143 (SK-744-CON9)

## METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit  
Account  
Number  
Deposit  
Account  
Name

03-1721

Choate, Hall and Stewart

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	770.
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)					(\$ ) 770.

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below		Fee Paid
Total Claims	20	-20** =	0	X		
Independent Claims	3	- 3** =	0	X		
Multiple Dependent						

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$ )

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ )

## SUBMITTED BY

Name (Print/Type)	C. Hunter Baker	Registration No. (Attorney/Agent)	46,533	Telephone	617-248-4801
Signature		Date	December 2, 2003		

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.  
SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**ATTORNEY'S DOCKET NUMBER: 2003080-0143 (SK-744-CON9)**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Danishefsky *et al.*  
Serial No.: not yet assigned  
Filed: December 2, 2003  
For: *Synthesis of Epothilones, Intermediates Thereto, Analogues and Uses Thereof*

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**EXPRESS MAIL NO: EV 314103476 US**

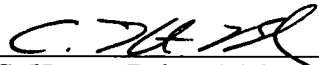
Sir:

**IDENTIFICATION OF PATENT UNDER 37 CFR § 1.607(c)**

As required by 37 CFR § 1.607(c), Applicants submit that the above-referenced application, as filed herewith on December 2, 2003, presents claims (claims 59-79) that correspond substantially to claims 1-21 of U.S. Patent 6,384,230, issued May 7, 2002.

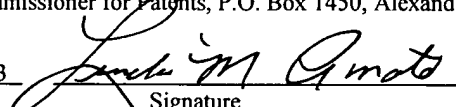
Please charge any fees or credit any overpayments to our Deposit Account No. 03-1721.

Respectfully submitted,

  
C. Hunter Baker, M.D., Ph.D.  
Registration Number: 46,533

Choate, Hall & Stewart  
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Date: December 2, 2003

<b>Certificate of Mailing</b>	
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Date	Signature
Linda M. Amato	
Typed or Printed Name of person signing certificate	